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Patent
Atty. Docket No. 11032/3002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

MERRIMAN, Dwight et al.

Serial No.: 09/094,949

Filed: June 15, 1998

For: METHOD AND APPARATUS FOR AUTOMATIC
PLACEMENT OF ADVERTISING

Examiner: J. HARLE

Art Unit: 3627

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APPEAL BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

Sir:

Applicants submit this appeal brief in the above-referenced application. A notice of appeal was filed on November 13, 2002, and the attached Petition For Extension of Time extends the due date.

REAL PARTY IN INTEREST

DoubleClick Inc. is the real party in interest for all issues related to this application by virtue of an assignment recorded with the Office at reel 9329, frame 0449.

RELATED APPEALS OR INTERFERENCES

An Notice of Appeal was filed on April 28, 2003 in reissue application No. 09/577,798, which includes similar subject matter. A Rule 607 Notice of Attempt to Provoke Interference was mailed March 10, 2003 for U.S. Pat 5,948,061 (issued September 7, 1999), which also includes similar subject matter.

STATUS OF CLAIMS

This application includes pending claims 85-100, all of which stand finally rejected as obvious over prior art. All rejections are appealed. Claims 1-84 have been previously canceled and are not included in this appeal.

STATUS OF AMENDMENTS

No Amendment After Final Rejection was filed in this application.

SUMMARY OF THE INVENTION

Embodiments of the present invention include a method, system or machine-readable medium for advertisement selection. Feedback is received from an advertiser Web site, the feedback representing user transactions at the advertiser Web site. The user transactions result from user response to at least one of a plurality of direct advertisements. When a request to display a direct advertisement to a user is received, one of the plurality of direct advertisements for display is selected based at least in part upon the advertiser feedback, as further explained below. The claimed invention allows feedback to be generated based on user response to at least one of a plurality of direct advertisements at an advertiser Web site, the feedback being received and used to select one of the plurality of direct advertisements so that the best performing advertisements may be selected. See page 6, line 2 through page 7, for example.

Figure 1 shows a predictive model 10 run on a server and having inputs including from a database of direct advertisements 14, database 16 and Database of Historical Statistics of Results of Advertisements 20. The predictive model processes inputs and outputs a direct advertisement, which is delivered to the user 22 through a medium 26, which may be a web page, for example. See page 10, last paragraph through page 11, line 12. The user may interact with a direct advertisement such that information may be fed to commerce engine 24 based on the user's interaction. The commerce engine is any electronic or physical infrastructure that facilitates a transaction. See page 11, lines 12-23. User transactions may include at least one of a sale, an order, a download and a click through. See page 13, lines 3-6, for example.

Feedback 25 from commerce engine 24 to the database of historical results on advertisements 20 may include information about a user's response to a direct advertisement. The feedback information is used by the predictive model 10 to refine future predictions about

optimal advertisements to deliver to the user. An advertisement server delivers stored advertisements based on the recommendation of the predictive model. See page 12, lines 4-16 and page 15, last two lines through page 16, line 2.

Figure 4 illustrates a specific embodiment of the invention. A user accesses affiliate Web site 412, which may include an advertising object 420 (such as a banner). Upon user selection of the advertising object 420, the browser is connected to the direct advertiser's Web site 416. Transaction results of the direct advertisement are reported back to the advertising server 414. Feedback from the advertiser Web site 416 may be by e-mail feedback 418, or through direct proxy 440. The advertising server 414, which includes predictive model 10, communicates with database 424 to select the advertisement stored therein based on the feedback. See pages 24-26.

ISSUES

- A. Whether claims 85-88,90-93, 95-98 and 100 are obvious over Kohda et al., "Ubiquitous advertising on the WWW: Merging advertisement on the browser" (hereinafter "Kohda") in view of Cespedes & Smith, "Database Marketing: New Rules for Policy and Practice", Sloan Management Review (hereinafter "Cespedes").
- B. Whether claims 89, 94 and 99 are obvious over Kohda in view of Cespedes and further in view of the Microsoft Press Computer Dictionary Third Edition.
- C. Whether claims 85-88, 90-93, 95-98 and 100 are obvious over Kohda in view of Bill Harvey, "The Expanded ARF Model: Bridge to the Accountable Advertising Future", Journal of Advertising Research (hereinafter "Harvey")
- D. Whether claims 89, 94 and 99 are obvious over Kohda in view of Harvey and further in view of the Microsoft Press Computer Dictionary Third Edition.

GROUPING OF CLAIMS

Group I: Claims 85-99.

Group II: Claim 100.

Separate reasons for patentability for each group are set forth below.

ARGUMENT

Independent claims of the present application recite a method, system or machine-readable medium for advertisement selection that includes receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements, and selecting, in response to a request for display of an advertisement to a user, one of the plurality of direct advertisements for display based at least in part upon the advertiser feedback. The prior art cited in the Final Rejection does not disclose or suggest receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements. The prior art does not receive feedback representing user transactions resulting from user response to at least one of a plurality of direct advertisements, and then select a direct advertisement from the same plurality of direct advertisements, as required by the present claims. Further, the Examiner has failed to establish anticipation or obviousness of claim 100 because the Examiner has failed to analyze the means language of claim 100 as required by 35 U.S.C. §112, paragraph 6.

The Final Rejection

The Final Rejection rejects claims 85-100 for the reasons set forth in the previous Office Action, mailed February 20, 2003, which it incorporates by reference. However, statements in the Final Rejection are in conflict with statements in the February 20, 2003 Office Action such that it is unclear whether the Examiner is rejecting the claims under 35 U.S.C. §102 or under 35 U.S.C. §103, as further explained below.

In the February 20, 2002 Office Action (which the Examiner indicates contains the reasons for which the claims are now rejected), the Examiner rejects the claims under 35 U.S.C. §103 as obvious over Kohda in view of various secondary references. In fact, the Examiner states:

“Examiner agrees that Kohda, et al., Angles, et al. and Marsh do not teach selecting one of the plurality of direct advertisements for display based at least in part upon the advertiser feedback.” See page 3, lines 3-5.

“Kohda, et al., does not teach that the selection of the advertisement be based at least in part upon advertiser feedback.” See page 4, last 2 lines.

However, in a section of the Final Rejection entitled "Response to Arguments", the Examiner asserts that Kohda discloses that a click-through/link from a user's augmented Web browser is a "direct result" of the advertiser's Web site and thus is feedback from the advertiser's Web server. See page 4. The Examiner thus appears to be asserting that Kohda discloses receiving from an advertiser Web site feedback representing user transactions at the advertiser's Web site.

Thus, it is unclear whether the Examiner is rejecting the claims over Kohda alone as a §102 rejection, or over Kohda in view of the secondary references as §103 rejections. Clarification is requested, but in either event, the cited references do not anticipate or render obvious any of the pending claims.

The Claimed Invention is Patentable

The claimed invention selects advertisements by receiving advertiser feedback from an advertiser Web site, the feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements. Then, when a request is received to display an advertisement to the user, one of the plurality of direct advertisements for display is selected based at least in part upon the advertiser feedback. Importantly, the feedback results from user responses to advertisements at the advertiser Web site.

Kohda Does Not Receive Feedback From an Advertiser Web Site

Kohda does not disclose or suggest receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements, as recited in independent claims 85 and 90. In contrast, Kohda discloses obtaining information for selecting advertisements from the user or from the user's augmented Web browser, not from an advertiser's Web site, as further explained below.

Kohda uses an advertising agent's Web server to deliver advertisements to users. First, the advertising agent makes a contract with advertiser companies to deliver advertisements to users. Then, the advertising agent negotiates with users, who agree to see advertisements while browsing. The users are allowed to specify what categories of advertisements they wish to see. See page 1494, col. 1, last 5 lines, col. 2 and Fig. 2. Kohda indicates that the agent

company should offer some clear benefit to attract the users, such as paying for all or part of the customers connection charges. See page 1495, col. 1, first full paragraph.

In Kohda, users who have made a contract with the advertising agent are given a Web browser that knows how to receive advertisements from the agent. The browser is an augmented Web browser, which uses filters that are invoked when an anchor is clicked in the browser's window. At invocation, environment information is passed to each filter program as invocation parameters. The environment information includes at least the identity of the user and information about the selected anchor. The invocation parameters are passed from the browser on the user's computer to the agent's Web server. The agent's Web server returns one of its advertisements or other information to be merged into a Web page. See page 1497, col. 1, lines 3-9 and col. 2, lines 4-8.

Thus, in Kohda, the advertisements are chosen based on information obtained from the filters stored on the user's augmented Web browser, and based on the user specifying what categories of advertisements he/she wants to see. Both types of information come from the user, not from the advertiser's Web site, as required by all independent claims of the application.

In the Final Rejection, the Examiner asserts that click-throughs/utilization of links from the augmented web browser, passed on from the user's machine to the advertising agent, is "a direct result of the advertiser's Web site, and thus is feedback from the advertiser's Web server." See pages 2 and 3. Applicant's claims do not recite receiving feedback from a user formed as a direct result of an advertiser's Web site, and Applicants object to such an interpretation of the claims. The Examiner's interpretation improperly changes the scope of the claims, which recite receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site.

None of the secondary references (Cespedes, Harvey) used to reject the independent claims of the present application disclose or suggest receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements, as recited in independent claims 85 and 90. Further, none of the secondary references provide any motivation to modify the structure of Kohda to include feedback from the advertiser Web site. Kohda specifically teaches receiving information from the user, through the filters on the

augmented Web browser stored on the user's computer. The cited references provide no motivation to move the Kohda filters to an advertiser's Web site, or to otherwise modify Kohda to receive feedback from the advertiser's Web site. Thus, even if the secondary references were combined with Kohda, the resulting combination would not teach or suggest receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements.

Kohda Does Not Select an Advertisement For Display From Among the Same Plurality of Advertisements To Which The User Responded

Kohda does not disclose or suggest receiving feedback representing user transactions resulting from user response to at least one of a plurality of direct advertisements, and then selecting, based at least in part on the advertiser feedback, a direct advertisement from the same plurality of direct advertisements, as required by independent claims 85 and 90. While a user in Kohda may be browsing an advertisement on a Web site, and the augmented Web browser may send information to the agent's Web server to use in selecting an advertisement, Kohda does not teach or suggest selecting an advertisement for display to the user from among a plurality of advertisements that led to a transaction at the advertiser's Web site.

By receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the presently claimed invention provides distinct advantages as compared to the cited references. In particular, by receiving feedback from an advertiser Web site, the presently claimed invention does not require negotiating with and making a contract with a user to accept an augmented Web browser having filters, or require offering some clear benefit to attract the users, such as paying for all or part of the customers connection charges, as explicitly required by Kohda. Instead, by receiving the feedback from the advertiser's Web site, the claimed invention can select advertisements based on the feedback, and not involve the cumbersome augmented Web browser of Kohda.

Accordingly, the cited references do not anticipate or render obvious claims 85 or 90, or any claims dependent therefrom, and the rejections should be withdrawn.

Means Claim 100 is Not Obvious

Claim 100 of the present application recites elements written in means-plus-function format under 35 U.S.C. §112, paragraph 6. The Examiner has failed to properly interpret claim 100 as required by 35 U.S.C. §112, paragraph 6, which requires that such a claim shall be construed to cover the corresponding structure described in the specification, and equivalents thereof.

The Court of Appeals for the Federal Circuit has mandated construction of means-plus-function claims. In *Lockheed Martin Corp. v. Space Systems/Loral*, 249 F.3d 1314, (Fed. Cir. 2001), the Federal Circuit acknowledged that the construer of claims first identifies the claimed function.¹ Once this function is identified, the Federal Circuit stated that the construer of claims must then construe this function using the ordinary principles of claim construction to find the “plain English” meaning of the function. Finally, the Federal Circuit stated that the construer then identifies the corresponding structure disclosed in the patent specification for performing the function. *Id.* at 1324.

The Examiner has failed to establish a prima facie case of obviousness or establish anticipation of claim 100 because the Examiner has failed to construe claim 100 by identifying the recited function, identifying the corresponding structure in the specification that performs the recited function, and determining whether the prior art discloses that structure or equivalent structure. Claim 100 of the present application recites, *inter alia*,

“means for receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements.”

The function recited in this claim is receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements. The recited functionality requires that the feedback be received from an advertiser Web site. The Examiners interpretation of the recited “from an advertiser Web site” to be read on by Kohda’s receipt of

¹ The claimed function may neither be narrowed nor limited beyond the scope identified in the claim language, nor improperly broadened by ignoring clear limitations contained in the claim language. See *Lockheed Martin Corp. v. Space Systems/Loral*, 249 F.3d 1314, 1324 (Fed. Cir. 2001).

filtered information from a user's augmented Web Browser is an improper broadening of the claim language.

The specification discloses that the structure that performs the recited function is the advertising server 414, that may receive feedback from the direct advertiser Web site 416, based on user transactions at the advertiser Web site 416, the user transactions resulting from user response to at least one of a plurality of direct advertisements, for example. See pages 24-26.

None of the recited references disclose or suggest this structure or equivalents thereof. In particular, the cited references do not disclose or suggest an advertiser server that receives feedback from an advertiser Web site. As explained above, the information that Kohda's advertising agent Web server receives is from the augmented Web browser at the users computer, and not from an advertiser's Web site. The Kohda structure of utilizing the augmented Web browser with filters to send information to the advertising agent's Web server is not equivalent to receiving feedback from a direct advertiser Web site. As explained above, Kohda's augmented Web browser arrangement requires the advertiser's agent to negotiate with and making a contract with a user to accept the augmented Web browser having filters, and require offering some clear benefit to attract the users, such as paying for all or part of the customers connection charges. The secondary references do not solve these deficiencies of Kohda.

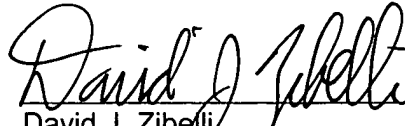
For at least the above reason, it is submitted that the cited references do not anticipate or render obvious claim 100.

CONCLUSION

Applicant respectfully requests reversal of the rejections of claims 85-100. These claims are allowable over the cited art.

Respectfully submitted,

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David J. Zibelli
Registration No. 36,394

KENYON & KENYON
1500 K Street, N.W.
Washington, D.C. 20005
Ph.: (202) 220-4200
Fax.: (202) 220-4201

APPENDIX

CLAIMS ON APPEAL

85. A method for advertisement selection, comprising:

- (a) receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements;
- (b) receiving a request to display a direct advertisement to a user; and
- (c) selecting, in response to the request, one of the plurality of direct advertisements for display based at least in part upon the advertiser feedback.

86. The method of claim 85, further comprising compiling from the advertiser feedback a historical statistical conversion rate for each of the at least one of a plurality of direct advertisements, and wherein the selection of one of the plurality of direct advertisements is based at least in part upon its historical statistical conversion rate.

87. The method of claim 85, wherein user transactions include at least one of a sale, an order, a download and a click through.

88. The method of claim 85, wherein the advertiser feedback is received via e-mail.

89. The method of claim 85, wherein the advertiser feedback is received via a direct proxy server.

90. A computer system for advertisement selection, comprising:

- a storage device configured to store a plurality of direct advertisements;
- a communications device configured to communicate with an advertiser Web site and a user; and
- an advertisement server configured to receive from the advertiser Web site via the communications device feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of the plurality of direct

advertisements, the advertisement server further configured to receive from the user via the communications device a request to display a direct advertisement, the advertisement server further configured to select, in response to the user request, one of the plurality of direct advertisements for delivery from the storage device to the user based at least in part upon the advertiser feedback.

91. The system of claim 90, wherein the advertisement server is further configured to compile from the advertiser feedback a historical statistical conversion rate for each of the at least one of the plurality of direct advertisements, and wherein the selection of one of the plurality of direct advertisements is based at least in part upon its historical statistical conversion rate.

92. The system of claim 90, wherein user transactions include at least one of a sale, an order, a download and a click through.

93. The system of claim 90, wherein the advertisement server is further configured to receive the advertiser feedback via e-mail.

94. The system of claim 90, wherein the advertisement server is further configured to receive the advertiser feedback via a direct proxy server.

95. A machine-readable medium storing instructions adapted to be executed by a processor to:

- (a) receive from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements;

- (b) receive a request to display a direct advertisement to a user; and

- (c) select, in response to the request, one of the plurality of direct advertisements for display based at least in part upon the advertiser feedback.

96. The medium of claim 95, further comprising instructions to compile from the advertiser feedback a historical statistical conversion rate for each of the at least one of a plurality of direct advertisements, and wherein the selection of one of the plurality of direct advertisements is based at least in part upon its historical statistical conversion rate.

97. The medium of claim 95, wherein user transactions include at least one of a sale, an order, a download and a click through.
98. The medium of claim 95, wherein the advertiser feedback is received via e-mail.
99. The medium of claim 95, wherein the advertiser feedback is received via a direct proxy server.
100. A computer system for advertisement selection, comprising:
- (a) means for receiving from an advertiser Web site feedback representing user transactions at the advertiser Web site, the user transactions resulting from user response to at least one of a plurality of direct advertisements;
 - (b) means for receiving a request to display a direct advertisement to a user; and
 - (c) means for selecting, in response to the request and the advertiser feedback, one of the plurality of direct advertisements for display based on a predictive model.